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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,715	03/31/2004	Robert P. Morris	1226/US	7428
49278	7590	10/09/2007	EXAMINER	
SCENERA RESEARCH, LLC			DAFTUAR, SAKET K .	
111 Corning Road			ART UNIT	PAPER NUMBER
Suite 220			2151	
Cary, NC 27518			MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/813,715

Applicant(s)

MORRIS, ROBERT P.

Examiner

Saket K. Daftuar

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 06/12/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-38 are presented for the examination.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 18-34 recites the limitation "computer readable medium".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Geiger et al U.S. Patent Number 6,073,142 (hereinafter Geiger).

As per claim 1, Geiger discloses (a) receiving an electronic message [incoming messages] for a client [for the recipient] (see column 1, line 49-57);(b) determining if the electronic message matches at least one criteria of a filter [rules, business rules], wherein at least one action is associated with the filter (Abstract, column 3, lines 30-61; examiner considers "Each business rule describes a particular action to be applied to an e-mail message in response to

either attributes of the e-mail message or performance data of the post office. For example, a business rule may specify actions such as deleting the e-mail message, gating the e-mail message for further review, copying the e-mail message, returning the e-mail message to its sender without delivering it....” as electronic messages matches at least one filtering criteria and action associated with the filter); and (c) if the electronic message matches the criteria, displaying a graphic associated [“graphic buttons”] with the action when the electronic message is viewed at the client and executing the action if the graphic [“graphics can be a plurality of buttons displayed as part of the electronic message”, specification page 7 such as action buttons at GUI] is selected (Figures 19-20s a screen shot of graphical user interface of action gatekeeper that shows graphic buttons and rules status [filtering status] for each message, see Figure 19-20, blocks 1907, 1909, 1911, 1913, 1915 are graphic buttons associated with business rules, column 23, lines 5-36).

As per claim 2, Geiger discloses (b1) adding the action associated with the filter to an action list for the electronic message, if the electronic message matches the criteria (see figures 6-8 for editing checkpoint rules and figures 16-17 for editing roles, column 9, line 60 – column 10, line 31).

As per claim 3, Geiger discloses (b1i) receiving a plurality of filters configured for a recipient of the electronic message (see figures 6-8 for checkpoint rules and figures 16-17 for editing roles, column 9, line 60 – column 10, line 31; tables 1-7); (b1ii) comparing the electronic message against criteria

of each of the plurality of filters (column 18, line 56- column 19, line 51); (b1iii) for each filter with criteria matching the electronic message, adding an action associated with the filter to an action list [see column 19, line 52 – column 21 line 24] for the electronic message (column 18, line 56- column 19, line 51); and (b1iv) placing the electronic message with the action list in the recipient's inbox (see column 19, line 52 – column 21 line 24).

As per claim 4, Geiger discloses (c1) inserting computer code into the electronic message if the electronic message matches the criteria, wherein the computer code displays the graphic [graphics can be a plurality of buttons displayed as part of the electronic message, specification page 7 such as action buttons at GUI] associated with the action when the electronic message is viewed at the client and executes the action if the graphic is selected ((see Figure 19-20, blocks 1907, 1909, 1911, 1913, 1915 are graphic buttons, column 23, lines 5-36)).

As per claim 5, Geiger discloses (c1i) receiving from the client a request for the electronic message; (c1ii) obtaining the electronic message from the recipient's inbox; and (c1iii) inserting a graphic associated with each action in the action list into the electronic message (column 1, line 35 - column 2, line 14, see figure 19-20 GUI for displaying inbox).

As per claim 6, Geiger discloses (c1) determining that the client [sender or recipient] is a supported client; (c2) adding the action list to the electronic

message; and (c3) sending the electronic message to the client (see column 23, lines 5- 52).

As per claim 7, Geiger discloses (d) receiving a selection of the graphic [GUI]; (e) checking for a plug-in associated with the action at the client [user application program]; and (f) invoking the plug-in, if the plug-in is found (see column 21, line 26 – column 22 line 10).

As per claim 8, Geiger discloses (g) requesting the plug-in from a plug-in server, if the plug-in is not found; (h) receiving the plug-in from the plug-in server [server loads and executes]; (i) installing the received plug-in; and (j) invoking the plug-in (see column 21, line 26 – column 22 line 10).

As per claim 9, Geiger discloses (d) receiving a selection of the graphic; (e) sending an action request for the action associated with the selected graphic to a server; and (f) processing a response to the request from the server (column 23, lines 5-36).

As per claim 10, Geiger discloses (g) receiving the action request by the server ;(h) invoking a plug-in [application program] associated with the action; and (i) sending a response to the action request to the client (column 1, line 35 - column 2, line 14; see column 21, line 26 – column 22 line 10).

As per claim 11, Geiger discloses the criteria of the filter are customizable for a recipient (see Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules).

As per claim 12, Geiger discloses the action is customizable for a recipient (see Figure 4B, for automatic and manual review with Figures 6-8 that shows different options to configure filters and rules).

As per claim 13, Geiger discloses the determining step (b) is performed at a mail server (column 1, line 25 – column 2, line 44).

As per claim 14, Geiger discloses the determining step (b) is performed at the client (column 1, line 25 – column 2 line 44).

As per claim 15, Geiger discloses the determining step (b) is performed at a relay [post office/mail servers] server (column 1, line 25 – column 2 line 44).

As per claim 16, Geiger discloses a cellular phone; a personal computer; a personal digital assistant; and an image capture device (see abstract, computer system).

As per claim 17, Geiger discloses the method of claim 1, wherein the electronic message comprises a file attachment, wherein the file attachment comprises an image filter (see figure 14, block 1412 for attachments rule).

As per claims 18-34, claims 18-34 are computer readable medium claims of method claims 1-17, respectively. They do not teach or further define over the limitation as recited in claims 1-17. Therefore, claims 18-24 are rejected under same scopes as discussed in claims 1-17, supra.

As per claims 35-36, claims 35-36 are system claims of method claims 1, and 7-8. Therefore, claim 35 – 36 also recites the limitation as discussed in claims 1 and 7-8, supra. In addition to method claims limitation 1 and 7-8, claims

35-36 further discloses a storage medium, mail server and plug-in server for storing filters and application programs [see column 1, line 25 – column 2 line 44].

As per claims 37-38, claims 37-38 are system claims of claims 1-17 and 35-36, respectively. They do not teach or further define over the limitation as recited in claims 1-17 and 35-36. Therefore, claims 37-38 are rejected under same scopes as discussed in claims 1-17 and 35-36, supra.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See accompanying PTO 892.

a. Computer Code for Removing Junk Email Messages by Pang U.S. Patent Number 6,167,434.

b. Method and Apparatus for Providing Automatic E-Mail Filtering Based on Message Semantics, Sender's E-mail ID and User's Identity by Mastrianni U.S. Patent Number 6,941,466 B2.

6. A shortened statutory period for reply to this non-final action is set to expire **THREE MONTHS** from the mailing date of this action. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (See 35 U.S.C 133, M.P.E.P 710.02,71002 (b)).


Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saket K. Daftuar whose telephone number is 571-272-8363. The examiner can normally be reached on 8:30am-5:00pm M-W.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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